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EXAMINER

KUCAB, JAMIE R

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PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* SCOTT W. RAU,
9 SCOTT PHILIP BERTETTI,
10 and GERALD A. BEECHUM, JR.
11

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13 Appeal 2010-002991
14 Application 09/630,595
15 Technology Center 3600
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18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and STEVEN
19 D. A. MCCARTHY, *Administrative Patent Judges*.
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL

STATEMENT OF THE CASE¹

Scott W. Rau, Scott Philip Bertetti, and Gerald A. Beechum, Jr. (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 26, 28-33, and 35-40, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a transponder activated account transaction (Specification 1:5-7).

An understanding of the invention can be derived from a reading of exemplary claim 26, which is reproduced below [bracketed matter and some paragraphing added].

26. A method of authorizing transponder-enabled transactions, comprising:

[1] receiving

by a transponder server of an issuing bank, a financial institution or a credit network

at least some RFID transponder identification information

emitted from an RFID transponder

substantially upon presentation of both the RFD transponder and a transaction for payment at a point of sale device, the payment comprising a payment amount;

[2] retrieving from an account table

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 4, 2007) and Reply Brief ("Reply Br.," filed February 6, 2009), and the Examiner's Answer ("Ans.," mailed October 6, 2009).

1 at least some financial account information linked to the
2 RFID transponder identification information,
3 the financial account information comprising at least one
4 of

5 account number information,
6 account type information,
7 account balance information, and
8 account limit information;

9 [3] determining by an authorization unit

10 authorization for charging at least some of the payment
11 amount

12 to a financial account represented by the financial
13 account information

14 based on the payment amount and at least some of
15 the financial account information; and

16 [4] communicating authorization to the point of sale device,

17 [5] wherein the RFID transponder identification information

18 does not comprise account number information.

19 The Examiner relies upon the following prior art:

20 Moskowitz US 5,528,222 June 18, 1996

21 The Bank Credit Card Business (2nd ed. American Bankers Association
1996) ("ABA").

22 Claims 31 and 32 stand rejected under 35 U.S.C. § 112, second
23 paragraph, as failing to particularly point out and distinctly claim the
24 invention.²

² Although the rejection nominally includes claims 30 and 33 (Answer 5),
the rejection as to these claims is withdrawn at Answer 4. The reference to

1 Claims 26, 28-33, and 35-40 stand rejected under 35 U.S.C. § 102(e) as
2 anticipated by Moskowitz, or in the alternative, under 35 U.S.C. § 103(a) as
3 unpatentable over Moskowitz and ABA.

4 ISSUES

5 The issue of indefiniteness turns on the construction of RFID (Radio
6 Frequency Identification) transponder identification information in claims 31
7 and 32. The issue of obviousness turns on whether multiple pieces of RFID
8 data, some of which constitute account number data, and some of which
9 does not, is within the scope of claim 26.

10 FACTS PERTINENT TO THE ISSUES

11 The following enumerated Findings of Fact (FF) are believed to be
12 supported by a preponderance of the evidence.

13 *Facts Related to the Prior Art*

14 *Moskowitz*

15 01. Moskowitz is directed to construction of a thin radio frequency
16 tag. Moskowitz 1:6-9.

17 02. Moskowitz shows a credit card containing an RFID chip.

18 Moskowitz: Fig. 12 and 7:20-21.

19 *ABA*

20 03. ABA is directed to an explanation of bank card processing.

21 ABA:Title.

claim 33 itself is in turn a typographic error, as the Examiner had instead
rejected claim 36. Final Rej. 3.

04. The magnetic stripe on a bank card contains essential customer and account information. ABA: 202. This information must conform to standards (ABA 68). The Examiner points to Ruppert 32:54-63 to show that this standard information necessarily includes the customer name and account number. This finding is corroborated by the embossed information on the front of the card which the magnetic information replicates. ABA 65.

ANALYSIS

Claims 31 and 32 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

We are persuaded by the Appellants' arguments that it is clear that these claims merely recite how RFID information is communicated. The Examiner based the rejection on the Examiner's uncertainty as to whether the RFID data referred to in these claims is identical to that in parent claim 26. Clearly, the reference to such data in claims 31 and 32 is in general.

Claims 26, 28-33, and 35-40 rejected under 35 U.S.C. § 102(e) as anticipated by Moskowitz, or in the alternative, under 35 U.S.C. § 103(a) as unpatentable over Moskowitz and ABA.

We are unpersuaded by the Appellants' arguments that the references fail to show the limitations, particularly, the final limitation that certain RFID data is not account number data. The Examiner found that Markowitz showed a credit card where the magnetic stripe data was in addition or instead placed in an RFID chip. The Examiner then found that the data in this chip included some that was an account number and some that was not. As the first limitation does not require that it encompass all of the RFID

1 data, the Examiner found that the name portion of the data was within the
2 scope of limitation [1] in that the name of customer identified the
3 transponder as belonging to that customer. Limitation [1] does not specify
4 the particular character of identification. Since the customer's account table
5 at the financial institution processing the card's transactions necessarily has
6 the account number and balance, and this table is linked to the customer's
7 name, limitation [2] is necessarily met. Limitation [2] does not require that
8 the RFID information from limitation [1] be a unique index into the account
9 table, nor does this limitation specify the direction of the link. Limitation [2]
10 also does not specify the location of the account table. Limitations [3] and
11 [4] are simply necessary parts of any bank card transaction. This leaves
12 limitation [5] requiring that the particular data referred to in limitation [1]
13 not be the account number, which again the customer name is not.

14 Thus, while the Appellants apparently are arguing that the transponder
15 identification is not an account number per se, the disclosed implementations
16 show it to be an alias for a customer account number at a financial
17 institution, which it necessarily must be, for a merchant to actually achieve
18 funds from the financial institution for the authorized transactions. This
19 argument is not commensurate with the scope of the claims.³

20 As we find that claim 26 is obvious over the applied art, we need not
21 reach the issue of anticipation.

³ The Examiner should consider how well known the use of alias identifiers was in the data processing arts, and even whether such an alias is itself an account number, should the claims be narrowed to bring out this distinction.

CONCLUSIONS OF LAW

The rejection of claims 31 and 32 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is improper.

The rejection of claims 26, 28-33, and 35-40 under 35 U.S.C. § 103(a) as unpatentable over Moskowitz and ABA is proper.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 31 and 32 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is not sustained.
- The rejection of claims 26, 28-33, and 35-40 under 35 U.S.C. § 103(a) as unpatentable over Moskowitz and ABA is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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